



1653  
S. Cannon

PATENT  
ATTORNEY DOCKET NO. 01997/211003

Certificate of Mailing: Date of Deposit: April 5, 2004

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Susan M. Cannon

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Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: H. Robert Horvitz et al. Art Unit: 1653  
Serial No.: 09/888,243 Examiner: Gabriele E. Bugaisky  
Filed: June 22, 2001 Customer No.: 21559  
Title: RELATEDNESS OF HUMAN INTERLEUKIN-1 $\beta$  CONVERTASE  
GENE TO A *C. ELEGANS* CELL DEATH GENE, INHIBITORY  
PORTIONS OF THESE GENES AND USES THEREFOR

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

In reply to the Restriction Requirement that was mailed in connection with the above-captioned case on October 3, 2003, applicants provisionally elect the invention of Group 68, claims 13-16 and 19. The election is made with traverse.

Applicants submit that Groups 51-56, claims 12 and 18, in part, and Group 68, claims 13-16 and 19, share the same classification and subclass, and should be examined together because the claims are drawn to related inventions.

35 U.S.C. 121 states that "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one

of the inventions.” Regarding this requirement, the M.P.E.P. 808.02 states:

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

In addition, the M.P.E.P. 903.01 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

As detailed below, Groups 51-56 and 68 are inter-related and their search and examination would not present an undue burden.

The claims of Groups 51-56 and 68 are directed to polypeptides containing mutations in a highly conserved motif that is expected to be required for biological activity, nucleic acids encoding these polypeptides, and methods of using the polypeptides. Specifically, wild-type ICE, NEDD-2, and CED-3 polypeptides contain a highly conserved pentapeptide motif that includes amino acids 283-287 (QACRG) of ICE (SEQ ID NO:4) and corresponding amino acids of CED-3 (SEQ ID NO:2) and NEDD-2 (SEQ ID NO:28). These pentapeptide motifs contain the active cysteine (Cys 285 of ICE, 358 of CED-3, or 319 of NEDD-2) that is required for the cell death-inducing activity of CED-3.

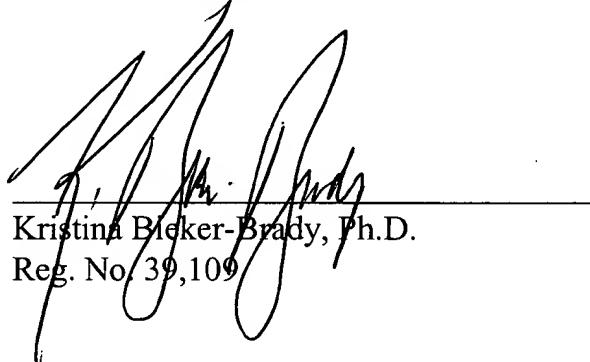
The claims of Groups 51-56 and 68 are inter-related in that they all encode mutant ICE, CED-3, or NEDD-2 polypeptides having a mutation in the highly conserved pentapeptide motif that affects cell death-inducing activity; examining these groups

together would not present an undue burden on the Examiner. Accordingly, applicants submit that Groups 51-56 and 68 should be examined together.

Enclosed is a Petition to extend the period for replying to the Restriction Requirement for five months, to and including April 5, 2004, since April 3, 2004 falls on a Saturday and a check in payment of the required extension fee.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,



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Date: April 5, 2004  
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